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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/535,734

11/03/2005

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EXAMINER

KNABLE, GEOFFREY L

ART UNIT

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1791

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/535,734	Applicant(s) NAKADA ET AL.	
	Examiner Geoffrey L. Knable	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/22/2009 has been entered.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 1, lines 3-4, it is defined that "all tire component members of the green tire" are assembled "one by one as one unit in an assembling sequence". The original disclosure does not however describe or characterize the invention in this manner and therefore this is subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, i.e. it is new matter. In particular, in view of applicant's arguments, it is apparent that this language is intended to be read as requiring that the component members that are assembled are always assembled individually one by one and is not inclusive of any preassembled

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components (i.e. it is argued that this is not inclusive of a belt/tread assembly).

However, there is no original descriptive support for such a requirement, at least if interpreted in this manner (the ambiguities in this language to be treated in a 35 USC 112, second paragraph rejection below). In fact, note for example that a carcass ply is a preassembly of two component members (the carcass cords and the rubber).

Further, tire components that are applied in symmetrical pairs are not applied one by one but are typically applied at the same time, there being no indication in the original disclosure otherwise. Further, as originally described, it is apparent that the components that are assembled can in fact include preassembled components - note for example that the bead cores can be preassembled with the bead fillers (paragraph [0059] on page 11 of the specification) and as well known in this art, even a bead filler is often inclusive of for example two component members of different hardness. As presently claimed, this would require that even the two different hardness filler component members are individually applied one by one (this being uncommon), it again being noted that there is no original descriptive support for this.

In claim 1, lines 6-7, upon reconsideration, it is not clear that there is original descriptive support for the reference to "two combinations of green tires of different sizes", this being therefore subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, i.e. it is new matter. In other words, the original disclosure seems to describe

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that the sequence includes a combination of tires having two different sizes (chosen from a group of sizes), not two different “combinations” as claimed.

4. Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 10 has been extensively amended but it is still not seen that the original disclosure describes this inventive procedure sufficient to practice the invention without an undue burden or experimentation and/or speculation. In particular, there is no *specific* discussion or description of how the claimed “correlation” is determined, and further, even if determined, it is not clear how or where it is further used in the method. Additionally, the somewhat more detailed part of the original disclosure discusses measuring the waveform of the runout for the carcass band CB, not the green tire, this creating further confusion in assessing how the invention as claimed is to be practiced, especially with measurement of the radial runout of a green tire as claimed, without an undue burden of speculation and/or experimentation.

5. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, lines 3-4, the scope of assembling all components “one by one as one unit in an assembling sequence” cannot be readily apparent ascertained. For example, the scope of what defines a “component” is not readily ascertainable and is important in

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assessing the scope of this requirement. Also, it is not even clear at present whether "one by one" refers to the components or the tires of different sizes. Also, it is not entirely clear what "as one unit" is referring to.

Claim 6, lines 2-3 seems to refer to the "members having a rubber ribbon" as if already defined (e.g. as in claim 4) but claim 6 does not depend from claim 4 and therefore no antecedent exists for this. It would appear therefore that claim 6, line 3 should be amended to for example change "having" to "and have" to avoid this ambiguity. An analogous ambiguity is present in claim 6, lines 6-8.

In claim 6, lines 5-6, it is confusing and seemingly inaccurate to describe that the rubber ribbon is the "member element" and then define that the ribbon is "laminated as said member element". It seems that this should more clearly define that the ribbon is laminated to form the tire component member (tread and sidewall). An analogous ambiguity is present in the last two lines of claim 6.

In claim 10, line 18, "band core" should apparently be "bead core".

In claim 10, it is also not clear how or whether the claimed determined correlation is further used in the method.

6. Claims 1, 3-5, 7-9, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 448,407 to Yamakawa et al. taken in view of Okada et al. (US 2001/0002608).

This rejection is maintained for substantially the same reasons as set forth in the last office action. As to the new requirement that all tire components are assembled one by one (apparently added to define over preassembling the belt and tread), the "BT

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band" is one component of the tire and is assembled to the rest of the tire being built.

While it is a composite component, as well known, many tire components are composites of different components (e.g. a carcass ply is a composite of tire cords and rubber; a bead/filler is a composite of bead core and filler; a bead filler is often a composite of two or more different layers, etc.). There is no indication in the original disclosure sufficient to support a more narrow reading of the term "component".

7. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP 448,407 to Yamakawa et al. taken in view of Okada et al. (US 2001/0002608) as applied to claim 1 above, and further in view of at least one of [Akiyama (US 6,475,319) and Ikeda et al. (US 2002/0074077)] as applied in the last office action.

8. Claims 1, 2, 9, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2002-254529 to Toyo Rubber (newly cited) taken in view of EP 448, 407 to Yamakawa et al.

JP '529 discloses a process of simultaneously producing different tire sizes (e.g. note Derwent abstract) including successively assembling the components of the tire. This includes disposing a cylindrical carcass band and two bead cores (CB) on a toroidal shaping drum (1/2) that includes bead locks (11 - note the figures and the included machine translation), followed by locking the bead cores, toroidally shaping the carcass, turning up the carcass around the beads (by 71/72) and moving the toroidal shaping drum to plural workstations (e.g. 301/302/303) where components including the belt and tread are applied while the beads are locked (esp. fig. 1). JP '529 thus discloses a process as claimed except it does not clearly specify details of the

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simultaneous tire building of different sizes and thus does not clearly specify that the sequence is specified in advance. To provide that the sequential building is preprogrammed and under control of a management system would however been seen as conventional and obvious in view of EP '407 which, like JP '529, suggests building different size tires on the same line using drums that are indexed between stations as illustrated in fig. 3. Further, it is clear that different tires are built in a desired sequence (e.g. col. 4, line 46 - col. 5, line 12; col. 7, lines 19-23) using a building sequence and selected components specified in advance. As to the tact time, the same comments as noted in the last office action apply equally here. In particular, as the tact time is in essence the sequential cycle time at the building stations (i.e. the working time plus any idle time waiting for the next station to clear), it reasonably follows that a controlled sequential building process in which drums are indexed from station to station (e.g. as suggested JP '529 as well as in fig. 3 of EP '407) would follow a certain "tact time". In other words, implicit in almost any simple indexed assembly line processing is a "tact time" (in essence the cycle time) - thus, as each drum can only occupy one position at a time and cannot advance to the next station until the next drum has also moved, there is a tact time implicit in the JP '529 (or EP '407) indexed sequential building process. Further, given the sequential nature of the plural drum assembling line type of processing, the tact time would have reasonably been understood as necessarily essentially equal to that at the processing station that takes the longest (since any given station can hold up the entire line), this essentially representing the tact time that governs the processing - this would be only the expected and predictable result. With

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respect to claim 9, it also would have been understood by the ordinary artisan and obvious that the station corresponding to the longest processing time should also have a minimized idle time (ideally zero idle time) since all the other stations would be waiting for this station to complete its work. Further, as every additional step must necessarily wait for the tact time (i.e. the time for the tire/drum to advance out of the preceding station), it would have been understood that subsequent steps of vulcanizing, inspecting, etc. as required by claims 11 and 12 would start after the tact time. A process as required by claims 1, 9, 11 and 12 would therefore have been obvious.

As to claim 2, note primary drum "PD", inclusion of an innerliner being implicit or certainly obvious and typical for any tubeless tire, as well known. The sidewall "SW" is also applied after turn-up (fig. 1 and paragraph [0029] of machine translation).

9. Claims 2-5, 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2002-254529 to Toyo Rubber (newly cited) taken in view of EP 448, 407 to Yamakawa et al. as applied above, and further in view of Okada et al. (US 2001/0002608).

As to claims 3-5, 7 and 8, JP '529 does not provide specifics of the structure or application of the various components at the various stations. To spirally wind and/or assemble narrow strips would however have been obvious in view of Okada et al. which suggest such techniques provide an ability to quickly change the specification of the tire being built - note also the more detailed description of this reference disclosure in this regard in the previous office actions.

Claim 2 has been also included within this rejection as further evidence of the well known and obvious inclusion of an innerliner.

10. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over [EP 448,407 to Yamakawa et al. taken in view of Okada et al. (US 2001/0002608)] or [JP 2002-254529 to Toyo Rubber (newly cited) taken in view of EP 448, 407 to Yamakawa and further in view of Okada et al. (US 2001/0002608)] as applied above, and further in view of Senbokuya et al. (US 6,616,783) as applied in the last office action.

11. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over [EP 448,407 to Yamakawa et al. taken in view of Okada et al. (US 2001/0002608)] or [JP 2002-254529 to Toyo Rubber (newly cited) taken in view of EP 448, 407 to Yamakawa et al.] as applied to claim 1 above, and further in view of WO 03/045675.

WO '675 (note equivalent US 2005/0142238 for a translation of this document) seems to disclose essentially the same procedure as defined in claim 10 to enhance uniformity of the tire (e.g. see claim 1 of the equivalent US publication), it being obvious to adjust the bead setting as claimed in a process as in the primary reference to enhance final tire uniformity.

12. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

13. Claim 10 is directed to an invention not patentably distinct from claim 1 of commonly assigned 10/497,069 (US 2005/0142238). Specifically, as noted above, the requirement of claim 10 seems to be essentially identically disclosed in this conflicting

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application, the remainder of the claim (i.e.. claim 1) being obvious in view of the cited art for the reasons already described.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned 10/497,069, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

14. Claim 10 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/497,069 in view of the prior art as applied against claim 1 in this office action. Specifically, as noted above, the requirement of claim 10 seems to be essentially identically disclosed in this conflicting application, the remainder of the claim (i.e.. claim 1) being obvious in view of the cited art for the reasons already described.

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This is a provisional obviousness-type double patenting rejection.

15. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

16. Applicant's arguments filed 6/22/2009 have been fully considered but they are not persuasive.

With respect to the prior art rejections, applicant's arguments stress the new “one by one” claim language and urge that EP ‘407 is preassembling the belt and tread and therefore does not read on the claim. As noted in the rejection however, this broad reference to “components” being assembled one by one does not define over the EP ‘407 teachings as the “BT band” can be defined as one component - note the statement of rejection. This argument is therefore not convincing. Note also the new rejection with newly applied reference JP ‘529 where the belt and tread are not preassembled.

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17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 571-272-1220. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Geoffrey L. Knable/
Primary Examiner, Art Unit 1791

G. Knable
August 30, 2009